REMARKS

This Response is to the Office Action dated May 5, 2004. In the Office Action, the Examiner rejected claims 1-7, 9-19, 21-23 and 25-30 under 35 U.S.C. § 103(a) as being unpatentable over David *et al.*, US Patent No. 6,449,632 (hereinafter *David*), in view of Barton *et al.*, US Patent No. 6,490,722 (hereinafter *Barton*).

No claim amendments are made herein. Accordingly, claims 1-7, 9-19, 21-23 and 25-30 remain pending in the application. For the reasons set forth below, the Applicants respectfully request reconsideration and allowance of all pending claims.

The IDS filed on 9/16/03 has not been acknowledged by the Examiner and respectfully asks that it be considered.

Traversal of the Rejection of claims under 35 U.S.C. § 103

To establish a *prima facie* case of obviousness, there must first be some suggestion or motivation to modify a reference or to combine references, and second be a reasonable expectation of success. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. Third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. M.P.E.P. § 706.02(j) from *In Re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Where claimed subject matter has been rejected as obvious in view of a combination of prior art references, a proper analysis under § 103 requires, *inter alia*, consideration of two factors: (1) whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed device; and (2) whether the prior art would also have revealed that in so making, those of ordinary skill would have a reasonable expectation of success. Both the suggestion and the reasonable expectation of success must be founded in the prior art, not in the Applicants' disclosure. *Amgen v. Chugai Pharmaceutical*, 927 F.2d 1200, 18 USPQ2d 1016 (Fed. Cir. 1991), *Fritsch v. Lin*, 21 USPQ2d 1731 (Bd. Pat. App. & Int'f 1991). An invention is non-obvious if the

references fail not only to expressly disclose the claimed invention as a whole, but also to suggest to one of ordinary skill in the art modifications needed to meet all the claim limitations. *Litton Industrial Products, Inc. v. Solid State Systems Corp.*, 755 F.2d 158, 164, 225 USPQ 34, 38 (Fed. Cir. 1985).

The examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. M.P.E.P. § 70602(j) from *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). Obviousness cannot be established by combining references without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done. M.P.E.P. § 2144 from *Ex parte Levengood*, 28 USPQ2d 1300, 1302 (Bd. Pat. App. & Inter. 1993) (emphasis added by M.P.E.P.).

In order to establish a prima facie case of obviousness, each of the references used in the §103 rejection must be a valid §102 reference. The Applicant respectfully asserts that neither David et al. (U.S. Patent No. 6,449,632) or the Barton et al. (U.S. Patent No. 6,490,722) qualifies as a §102 reference in view of the 37 C.F.R. §1.131 declaration and accompanying exhibits attached hereto. Accordingly, the current §103 rejection of pending claims 1-7, 9-19, 21-23 and 25-30 over the combination of the *David* and *Barton* prior art references cannot be supported for at least this reason, and thus must be withdrawn.

If the undersigned attorney has overlooked a teaching in any of the cited references that is relevant to the allowability of the claims, the Examiner is requested to specifically point out where such teaching may be found. Further, if there are any informalities or questions that can be addressed via telephone, the Examiner is encouraged to contact the undersigned attorney at (206) 292-8600.

Charge Deposit Account

Please charge our Deposit Account No. 02-2666 for any additional fee(s) that may be due in this matter, and please credit the same deposit account for any overpayment.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN

Date: Aug. 5, 2004

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Enclosure: C.F.R. §1.131 Declaration and Exhibits A and B.